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In re Application of
SCHNEIDER et al.
Application No.: 09/719,339
PCT No.: PCT/US00/10999
Int. Filing Date: 24 April 2000
Priority Date: 23 April 1999
Attorney Docket No.: ADAPP182D
For: WRITE CACHE FLUSHING METHOD FOR
REDUCING DATA CORRUPTION

NOTIFICATION

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371.

BACKGROUND

On 24 April 2000, applicants filed international application PCT/US00/10999, which claimed a priority date of 23 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 02 November 2000. The twenty-month period for paying the basic national fee in the United States expired at midnight on 23 December 2000.

On 08 December 2000, applicants filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date to Deposit Account No. 50-0951; a preliminary amendment; and an Information Disclosure Statement. These application papers were identified by applicants with attorney docket number ADAPP182D and were assigned application number 09/719,339.

On 08 December 2000, applicants also filed a second TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date to

Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including: (1) correction of the priority date to 23 April 2000 (rather than 12 December 1996); and (2) preparation and mailing of a NOTIFICATION OF A DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the declaration filed on 11 April 2001 is not in compliance with 37 CFR 1.497(a)-(b) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) indicating that the declaration filed on 11 April 2001 does not identify the application to which it is directed and does not identify the citizenship of each inventor.



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Enclosure: postcard receipt for application papers identified by applicants as having attorney docket number ADAPP182C including a USPTO date-stamp of 08 December 2000 and a USPTO stamp indicating application number 09/719,435 (This postcard apparently was inadvertently not mailed earlier as it was still with the application papers having attorney docket number ADAPP182C when they were forwarded to the undersigned.)

Deposit Account No. 50-0951; a preliminary amendment; and an Information Disclosure Statement. These application papers were identified by applicants with attorney docket number ADAPP182C and were assigned application number 09/719,435.

On 08 December 2000, applicants filed third and fourth TRANSMITTAL LETTERS (FORM PTO-1390) for entry into the national stage in the United States which were each accompanied by, *inter alia*, an authorization to charge the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date to Deposit Account No. 50-0951; a preliminary amendment; and an Information Disclosure Statement. These two submissions, identified by applicants with attorney docket number ADAPP182B and ADAPP182A, were placed in a single application file and were assigned application number 09/719,461.

On 22 March 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form DO/EO/905) for application number 09/719,339 indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 11 April 2001, applicants submitted a response to the NOTIFICATION OF MISSING REQUIREMENTS for application number 09/719,339, which was accompanied by, *inter alia*, a declaration of the inventors.

DISCUSSION

As is evident from the above recited facts, applicant submitted four sets of papers to enter the national stage for the same international application. The submission of four sets of national stage papers to enter the United States was improper.

35 U.S.C. 363 states:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application. All four Transmittal Letters filed 08 December 2000 indicate that each submission is a "filing under 35 U.S.C. 371" of PCT/US00/10999. No conflicting instructions appear in the application papers. Accordingly, each submission should have been treated as a

national stage application submitted under 35 U.S.C. 371. In that only one national stage of a PCT application is permitted, it would have been proper for all four of the submissions filed 08 December 2000 to be placed in a single application and assigned a single application number. Accordingly, all of the papers filed on 08 December 2000 have been placed in application number 09/719,339.

Applicant should use application number **09/719,339** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/US00/10999.

The declaration filed 11 April 2001 fails to comply with 37 CFR 1.497(a)-(b) because it fails to identify the citizenship of two of the three inventors. Also, the declaration is defective because it executes the wrong application; it executes the application as amended on 08 December 2000 rather than executing the international application. Amendments made on 08 December 2000 are not part of the international application. As noted above, application number 09/719,339 is a filing under 35 U.S.C. 371.

Preliminary Amendments

Only the preliminary amendment identified as having attorney docket number ADAPP182D has been and will be entered. The other preliminary amendments will be placed in the application file but will not be entered and will not be acted upon.

Information Disclosure Statements

It is noted that the Information Disclosure Statements accompanying all four submissions list the same references.

Fees

The fees accompanying the submission identified by applicants as having attorney docket number ADAPP182A were refunded on 09 January 2001.

The fees accompanying the submissions identified by applicants as having attorney docket numbers ADAPP182C and ADAPP182D will be credited to Deposit Account 50-0805.

CONCLUSION

For the reasons set forth above, all four of the submission filed 08 December 2000 have been placed in the file of application number 09/719,339.

Any further correspondence with respect to this matter should be addressed to the